

- IV. Claims 38, 39, 42, Drawn To A Third Composition, Classified In Class 530, Subclass Various.
- V. Claims 44-46, Drawn To A First Method Of Using The Second Composition, Classified In Class 426, Subclass Various.
- VI. Claim 47, Drawn To A Second Method Of Using The Second Composition, Classified In Class 436, Subclass Various.
- VII. Claims 48-52, Drawn To A Third Method Of Using The Second Composition, Classified In Class 536, Subclass Various.
- VIII. Claims 26, 27, 30 And 31, Drawn To A Composition As Defined By Cancelled Claim 1, Classified In Class 435, Subclass 183.

The Examiner also asserted that the claims are directed to potentially distinct species, i.e. "the many different components of the products." Office Action, page 3, last paragraph. The Examiner required that Applicants elect a single disclosed species for prosecution on the merits to which the claims will be restricted if no generic claim is finally held allowable. Office Action, page 4. Applicants were also required to list all claims readable on the species elected in accordance with the requirement. *Id.*

In a telephone conversation of September 24, 2002, the Examiner elaborated that he would like Applicants to elect a species disclosed in the specification for each of the possibilities in claim 33, and if no such species is possible to identify, he expected Applicants to identify a suitable sub-genus. The Examiner kindly indicated to the undersigned counsel during the conversation that if Applicants' election of species was not satisfactory to him, he would advise Applicants by telephone and, if necessary, provide additional time for a supplemental response.

II. ELECTION WITH TRAVERSE

Applicants elect, with traverse, for further prosecution the claims of Group III and the following species:



1. For an oxidizable substrate for galactose oxidase: the species of galactose oligomer or galactose dimer; *pick one*
2. For an enzyme which is capable of converting a compound into a substrate for the galactose oxidase: a galactanase, disclosed, e.g., at page 9, line 33; *B.K.*
3. For a galactose-containing substrate compound: a galactan, such as arabinogalactan or arabinose-free arabinogalactan, e.g., see page 7, line 23 - page 8, line 15. *for clm. 35?*

With respect to the identification of galactose oligomer or galactose dimer as a species or a sub-genus of the galactose-containing substrate for galactose oxidase, Applicants respectfully point out that persons of ordinary skill in the art, familiar with the specification and the claims, would readily recognize that the sub-genus is included in the first alternative for the second component of claim 33. The examination of claims of Group III (in the event that the restriction requirement is maintained) can readily proceed based on the Applicants' election of Group III and the identification of the sub-genuses and species identified above.

In the Office Action it was stated that the inventions identified in the above-identified purported separate groups are distinct from each other for several reasons. First, it was asserted that inventions of groups III and V - VII are related as product and process of use. It was also asserted that they can be shown to be distinct if either or both of the following can be shown:

1. the process for using the product as claimed can be practiced with another materially different product; or

2. the product as claimed can be used in a materially different process of using that product.

The MPEP, section 806.05(h) was relied upon for that assertion. It was said that in this application the product can be used in materially distinct methods of use, such as to treat cancer and as shown by the different uses claimed. Office Action, page 3.

It was additionally asserted that the different products are restricted from one another because they are materially distinct from each other, *i.e.*, an enzyme which is capable of converting a compound into a substrate for the galactose oxidase versus a compound naturally present in flour are different from one another.

Finally, it was also asserted that the different methods of using the compositions are restrictable from each other because they are not capable of being used together and require different modes of operation. Office Action, page 3.

Applicants respectfully traverse the restriction requirement and the election of species requirement. At the outset, Applicants respectfully submit that this application is a national phase of a PCT application, and, accordingly, the PCT unity of invention rules, rather than the restriction requirement rules of 35 U.S.C. § 121 must be applied. For at least that reason, claims 24-53, all claims present in the application, share the same special technical feature, *e.g.*, a galactose oxidase. This is emphasized by 37 C.F.R. § 1.475(b) which indicates, in pertinent part, that:

...a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) ...
- (2) A product and a process of use of said product; ...

Please also see, *Caterpillar Tractor Company v. Commissioner of Patents and Trademarks*, 590 USPQ 231 (DC, E.D. VA 1986) wherein the court held that a U.S. national stage of a PCT application containing claims directed to a process and apparatus for its practice must be examined in the same application since they satisfy the requirement of unity of invention of the PCT Rules. The same principle applies to claims directed to a composition and claims directed to methods of its use, present in this application.

Pursuant to the requirement in the Office Action, Applicants submit that at least the following claims are readable on the elected species and sub-genuses: claims 25-30, and 32-53.

In view of the above remarks, it is respectfully requested that the restriction requirement and the election of species requirement be withdrawn and that all claims be allowed to be prosecuted in the same application. In the event that the requirement is made final, and in order to comply with 37 CFR § 1.143, Applicants reaffirm the election of claim 28, 29, 32-37, 40-43 and 53 (Group III), holding the remaining claims (Groups I, II and IV - VIII) in abeyance under the provisions of 37 CFR § 1.142(b) until final disposition of the elected claims.

### III. MISCELLANEOUS

With respect to the Examiner's indication that claims 1 and 21 were canceled, Applicants respectfully wish to point out that claim 33 corresponds substantially to the canceled claim 1 and claim 50 corresponds substantially to the canceled claim 21. See page 6 of the Preliminary Amendment under 37 CFR § 1.115, filed on June 11, 2002.

IV. REQUEST FOR ALLOWANCE

All claims are in condition for allowance, an indication of which is solicited. In the event any outstanding issues remain, Applicants would appreciate a telephone call to the undersigned counsel to resolve such issues in an expeditious and effective manner.

It is believed that no additional fees are due in connection with this filing. However, in the event that any fees are necessary, the Commissioner is hereby authorized to charge our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

Dated: November 27, 2002

By: 

Stanislaus Aksman

Registration No. 28,562

1900 K Street, NW, Suite 1200  
Washington, DC 20006  
(202) 955-1926—Telephone  
(202) 778-2201—Facsimile